

Appl. No. 10/675337
Amdt. Dated 1-31-06
Reply to Office Action of 10-31-05

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application. Applicant confirms election of species 2, Group III, claim 19 to be examined on its merits. Applicant has amended the specification to overcome the minor informalities, as helpfully pointed out by the examiner.

Original Claims 16, 19 and 20 are Patentable

The following claimed recitations are neither taught nor rendered obvious by the prior art of record:

- a floss ... including a plurality of perforations spaced along a length thereof and for assisting a user to separate said floss at said perforations. Neither the Karos reference nor any other prior art of record discloses such a claimed limitation. Karos specifically teaches a string 14 and a separate tip 16 attached to the string 14 (see FIGS. 2 and 5) for assisting the user to separate the string 14. Karos simply does not teach or provide any suggestion for including a plurality of perforations in its string. The string 14 is separated into smaller sections by detaching the string 14 from an associated tip 16, without employing perforations in the string 14 (see column 3, lines 51-57).
- a plurality of applicators formed to be substantially tubular and having opposed end portions for passing said floss therethrough. A person of ordinary skill in the art would not combined Petrus' applicator 8 with Karos' string 14 because Karos simply has no need for Petrus' applicator. Petrus is intended to position its porous media 4 adjacent to a body cavity. In contrast, Karos' intended function is to clean a body piercing by passing its string 14 completely through the body piercing. A person of ordinary skill in the art would not look to combined Petrus' teachings with Karos for the purpose of cleaning body piercings as it would unnecessarily inhibit Karos' string 14 from penetrating and passing through the body piercing. Applicant respectfully submits the examiner must consider all of Petrus' teachings and not selectively build Applicant's claimed invention by combining non-analogous art. One skilled in the art simply would not have a

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desire to combine Petrus with Karos to pass Karos' string 14 through a tiny body piercing. Rather, Petrus' applicator 8 is intended to transport a string adjacent to an open and broad body cavity (such as an ear canal) and discharge a porous media in the ear canal (see column 5, lines 53 – 67), which is counter intuitive to Karos' teachings.

- a sterilizing substance coated on said inner surface and being transferable onto said floss as same passes through said plurality of applicators respectively so that a pierced body part may be cleaned as said floss is passed therethrough.

No prior art of record teaches or renders obvious such a claimed recitation.

Karos specifically teaches saturating the string 14 within a body of antiseptic fluid (column 2, lines 46 – 53, lines 58 – 61). Petrus simply provides no teaching on Applicant's claimed recitation.

Newly Submitted Claim 21 is Patentable

No prior art of record teaches or renders obvious the following claimed recitation:

- wherein said perforations traverse across a width of said string and are oriented perpendicular to a longitudinal length of said string.

Applicant respectfully submits no new matter has been introduced, which would affect the statutory requirements of patentability, because all newly claimed recitations are clearly supported by the original drawings. A person of ordinary skill in the art is enabled to make and use the presently claimed invention based on the originally filed drawings. Applicant has included case law, wherein the Court has held the claims may be amended based upon the originally filed drawings without triggering a new matter rejection (please see attached literature).

In view of these considerations, it is respectfully submitted that the rejection of the pending claims should be considered as no longer tenable with respect to the above mentioned arguments and claim amendments. All pending dependent claims necessarily include the recitations of their independent claims and therefore are also in condition for allowance.

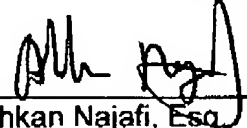
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Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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for later submitted claims does not warrant employment of §132 as a basis for rejection of later submitted claims on the ground that the latter are adding new matter to the original claim portion of the disclosure. To so hold would render §132 redundant in light of §112, first paragraph.⁴⁹²

The CCPA remarked that the originally filed specification described the step of applying the adhesive as follows: "[A]dhesive is applied to the tubular foil 4 in a narrow or broader strip, possibly in two narrow strips. Accordingly, the face of the tubular foil successively sticks to the winding lying on the drums."⁴⁹³ The specification thus described one method of adhering the various layers in the thermal insulation. On the basis of this description, the CCPA held that "one skilled in the art who read Rasmussen's specification would understand that it is unimportant *how* the layers are adhered, so long as they are adhered. Thus the phrase 'adheringly applying' is supported by the example found in the specification."⁴⁹⁴

Rasmussen therefore teaches that an original claim and examples in the specification may be used to support amendments after the application is filed.

C. Drawings That Provide Support for Amendments to Specification

Drawings may provide an adequate written description of the invention in the event the written disclosure portion of the application inadvertently omitted such a written description. *In re Wolfensperger*⁴⁹⁵ is an example of when the original drawings were used to provide, in part, the written description of the invention under Section 112, first paragraph. In *Wolfensperger*, the invention related to a ball-type valve used in high-pressure fluid pipelines. The valve contained a shut-off member constructed of a spherical ball plug. The Examiner and the Board rejected a specific claim of the patent application on the grounds that the claim was not adequately described in the specification. In particular, the claim recited a two-dimensional relationship including a "packing ring" in "untensioned condition" that included "a mean diameter corresponding approximately to the mean diameter of said chamber."⁴⁹⁶

On appeal, the CCPA reversed. The court disagreed with the Board's statement that it was well-established legal precedent that

⁴⁹²*Id.*, 211 USPQ at 326 n.5 (citing *In re Anderson*, 471 F.2d 1237, 1238, 176 USPQ 331, 332 (C.C.P.A. 1973)).

⁴⁹³*Id.*, 211 USPQ at 326.

⁴⁹⁴*Id.*, 211 USPQ at 327 (footnote omitted) (emphasis in original).

⁴⁹⁵*In re Wolfensperger*, 302 F.2d 950, 133 USPQ 637 (C.C.P.A. 1962).

⁴⁹⁶*Id.*, 133 USPQ at 638.

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drawings alone cannot constitute a written description of the invention. The CCPA stated as follows in this connection:

Consider, for one thing, that the sole disclosure in a design patent application is by means of a drawing. Rule 153. For another thing, consider that the only informative and significant disclosure in many electrical and chemical patents is by means of circuit diagrams or graphic formulae, constituting "drawings" in the case.⁴⁹⁷

The CCPA then described the general test for determining whether a drawing can constitute an adequate written description of the invention under Section 112, first paragraph:

The practical, legitimate enquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."⁴⁹⁸

The CCPA held that figure 5 of the application clearly showed that the ring had a mean diameter corresponding approximately to the mean diameter of an annular chamber.⁴⁹⁹ On this basis, the court held that the application satisfied the written description requirement. Thus, *Wolfensperger* teaches that drawings may provide the basis for subsequent amendments to the specification without producing prohibitory new matter therein.

D New Matter and Correcting Obvious Errors

An applicant may generally correct obvious errors in the application without introducing prohibitory new matter. For example, translation errors from foreign prior applications may generally be corrected.⁵⁰⁰ The general rule is that if the error can be detected and corrected by one of ordinary skill in the art, then the applicant may amend the application to correct the error without introducing new matter.⁵⁰¹

*Ex parte Brodbeck*⁵⁰² is an example of when an applicant was permitted to amend the specification to correct an obvious error. In *Brodbeck*, the invention related to a process of catalytic isomerization of a compound. Brodbeck sought to reissue his already-granted patent, U.S. Patent Number 3,647,898, by amending the claim portion of the application. The original claim 1 of the issued patent recited the lim-

⁴⁹⁷*Id.*, 133 USPQ at 541-42.

⁴⁹⁸*Id.*, 133 USPQ at 542 (emphasis in original).

⁴⁹⁹*Id.*, 133 USPQ at 541.

⁵⁰⁰See *In re Oda*, 443 F.2d 1200, 170 USPQ 268, 272 (C.C.P.A. 1971).

⁵⁰¹*Id.*

⁵⁰²*Ex parte Brodbeck*, 199 USPQ 230 (Pat. Off. Bd. App. 1977).